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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,376

02/14/2006

Hendrik Wermter

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1125

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EXAMINER

TESKIN, FRED M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/568,376	Applicant(s) WERMTER ET AL.	
	Examiner Fred M. Teskin	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11-16 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060501</u> . | 6) <input type="checkbox"/> Other: ____. |

This Office action is responsive to application filed on 14 February 2006. The accompanying preliminary amendment having been entered, claims 1-16 are currently pending and under examination herein.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6262206 (hereinafter "Nesvadba").

Applicants' invention, as recited in claim 1, is a polymerizable composition comprising

- a) an ethylenically unsaturated monomer;
- b) a radical polymerization initiator; and
- c) a hydroxylamine, a nitron or an alkyl N-oxid having a molecular weight of more than 250 g/mol.

Nesvadba discloses a composition substantially as claimed, differing only in that a radical polymerization initiator together with applicants' components a) and c) is not

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described in a single embodiment. See in particular Examples B13 – B17, B27, B28, B30, B32 and B36, which individually describe the synthesis of block copolymers from a composition comprising specific ethylenically unsaturated monomers and the substituted hydroxylamine compound No. 102, 105 or 106. Each of said compounds comprises an alkyl-N-O- moiety and has a molecular weight (calculated from the structures shown in Tables 1 and 2) of more than 250 g/mol [No. 102: 359; No. 105: 263; No. 106: 343]. While the polymerizable composition used in each cited example lacks a radical initiator, Nesvadba teaches that the polymerizable composition may include a radical initiator – most preferably an azo compound - in accordance with the “in-situ” process of generating an initiator compound of formula (I) as detailed at column 24, line 20 to col. 25, line 15. Thus, at the time of applicants’ invention it would have been obvious to one of ordinary skill in the art to modify Nesvadba by including a radical polymerization initiator corresponding to applicants' component b) as claimed (claims 2, 5, 6) in any of the aforementioned examples, motivated by a reasonable expectation of successfully obtaining an equivalent block copolymer product.

Claim 16 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nesvadba.

The discussion of Nesvadba set forth in the preceding rejection is incorporated herein by reference. Even in the absence of a radical polymerization initiator, the block copolymer products described in the above-cited examples of the reference would not be expected to differ substantially in structure or properties from the instantly claimed

(co)polymer. The disclosed processes would be expected to produce polymers identical to or insubstantially different from the claimed (co)polymer product based on the use of initiator compounds meeting the claim 11 limitations as to minimum molecular weight and alkyl-N-O functionality to produce block copolymers having molecular weight parameters commensurate with the corresponding parameters of applicants' (co)polymers. See, e.g., the values of Mn, Mw and PD as reported in Examples B13 and B15 – B17 of Nesvadba, which fall within the scope of molecular weight properties as described herein (*cf.*, page 11 line 30 to page 12, line 2 of the present Specification).

Where, as here, a product-by-process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden properly shifts to applicants to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 195 (Fed. Cir. 1983). This is especially true given the lesser burden of proof on the Office in making out a case of *prima facie* obviousness for product-by-process claims, because of their peculiar nature (M.P.E.P. 2113).

Claims 7-10 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim.

Any inquiry concerning this communication should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be

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reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred M Teskin/

Primary Examiner, Art Unit 1796